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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,121	04/20/2005	Uwe Hering	449122080500	5812
25227	7590	05/03/2006	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102				PHAN, THIEM D
ART UNIT		PAPER NUMBER		
		3729		

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Sp

Office Action Summary	Application No.	Applicant(s)
	10/532,121	HERING ET AL.
	Examiner Tim Phan	Art Unit 3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicants' election without traverse of Group I, Claims 1-8, filed on 2/23/06, is acknowledged.

The Restriction mailed on 1/23/06 has been carefully reviewed and is held to be proper.

Moreover Applicants did not distinctly and specifically point out any error in the Restriction Requirement. Accordingly, Claim 9 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim.

The Restriction filed on 1/23/06 is hereby **made Final**.

Applicants are required to cancel the nonelected claim (9) or take other appropriate action.

An Office Action on the merits of Claims 1-8 now follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Since these claims are narrative in form and replete with indefinite and functional or operational language, they are written in such a fashion that they are not active verbs and therefore the metes and bounds of the claimed invention is difficult, if not impossible, to determine. For example, in claim 1 the language "... a drive opening for introducing a drive movement;" (lines 3 & 4) is confused and awkward, it is unclear and vague why, how and what "a drive movement" relates to "a drive opening"; and the claimed limitations "... is provided with..." (line 8), "... is fixed in..." (line 9), "... the sheath provided with ..." (line 10), "... being filled with ... " (line 12), etc ... are passive and not in a form which clearly delineates the scope of the claims in U.S. Patent practice; in claim 2, the language "... and/or ..." is confused and indefinite; etc ...

Also the processed structure, which goes to make up the "breaker pole" must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Note the format of the claims in the patents cited.

Furthermore, Claim 1 recites the limitations "from one another" (line 5), "the breaker" (line 5) and "the breaker housing" (line 9). There is insufficient antecedent basis for these limitations in the claim.

Applicants would do well if they carefully review and rewrite the claims with the view of using positive, active language in order to properly claim any patentable subject matter in the merits.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Luzzi (US 5,864,942).

With regard to claim 1, Luzzi teaches a method for making high voltage switch or breaker pole (Fig. 1), comprising:

- providing a drive opening (Fig. 1, 18) for introducing a drive movement;
- producing, independently from one another, when the breaker has a switching housing (Fig. 1, 36), which has a drive side through which a switching rod passes (Fig. 1, 108), and a dimensionally stable sheath or outside cover (Fig. 1, 10), which is made from insulating or dielectric material and is provided with a connection part (Fig. 1, 58);

- when the breaker is fixed in the sheath such that the breaker housing, with the exception of the drive side, and the sheath provided with the connection part delimit an intermediate space which is open towards the drive opening, the intermediate space being filled with a fluid compensating compound (Fig. 1, 32; col. 5, lines 40-43); and
- curing (Col. 6, lines 21-23) the compensating compound.

With regard to claim 8, Luzzi teaches that the connection part (Fig. 1, 58) is cast into the sheath (Fig. 1, 10 or 22) when the latter is produced.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luzzi.

With regard to claims 2 and 3, Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 32), which reads on applicants' claimed invention; except for having a casting channel for

filling, located in the sheath or housing (Fig. 1, 10) or arranged below the immediate space of the insert for filling.

It is mere matter of design choice to have a casting channel for filling, located in the sheath or housing, or arranged below the immediate space of the insert for filling, since it is known in the art that the fluid compensating compound or insert has to be mold (Col. 9, lines 26-30) and it appears that the invention would perform equally well with the molding process taught by Luzzi.

With regard to claims 6 and 7, Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 32) for curing (Col. 6, lines 20-23), which reads on applicants' claimed invention; except for having a casting channel for inserting the filler being sealed with insulating material after filling.

It would be obvious to one of ordinary skill in the art at the time the invention was made to seal the filling channel with an insulating material in order to cure the filling material.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luzzi in view of Seki et al (US 5,698,008).

Luzzi teaches a method for making high voltage switch or breaker pole, including the steps of molding the fluid compensating compound or insert (Fig. 1, 32) and applying a filling under some pressure (Col. 7, lines 33-37), which reads on applicants' claimed invention.

Seki et al teach a method of making vacuum valve by applying under vacuum atmosphere

and molding pressure in order to improve the withstand voltage characteristic.

It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the molding under vacuum and pressure, as taught by Seki et al, to the method of molding the fluid compensating compound or insert, as taught by Luzzi, in order to improve the withstand voltage characteristic of the insert.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3729

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan
Examiner
Art Unit 3729

tp
April 27, 2006



A. DEXTER TUGBANG
PRIMARY EXAMINER